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| In re Application of | : | |
| Medley | : | |
| Application No.: 10/579,786 | : | DECISION |
| PCT No.: PCT/US03/04507 | : | |
| Int. Filing Date: 19 February 2003 | : | ON |
| Earliest Priority Date: 22 February 2002 | : | |
| Attorney Docket No.: 25815-100-03 | : | PETITION |
| For: Magnetic Label Stock Material | : | |

This is in response to the renewed submission under 37 CFR 1.497(d) filed on 09 June 2011.

DISCUSSION

In a Decision mailed on 24 May 2011, the submission under 37 CFR 1.497(d) filed on 12 January 2011 was dismissed, without prejudice, because

Regarding requirement (3), applicant filed a "Written assent of assignee" on 23 August 2006, implying that Magnum Magnetics Corporation is an assignee of the instant application. 37 CFR 1.497(d)(3) requires "If an assignment has been executed by any of the original named inventors, the written consent of the assignee (see § 3.73(b) of this chapter)." This is consistent with the policy described at MPEP 324 ("When an assignee first seeks to take action in a matter before the Office with respect to a patent application, patent, or reexamination proceeding, the assignee must establish its ownership of the property to the satisfaction of the Director."). Here, the action to be taken is the assignee's consent to the change in inventorship. MPEP 324 expressly lists the situation where an assignee "consents to the correction of inventorship" as among the situations requiring submission of a statement under 37 CFR 3.73(b). Therefore, since applicant previously indicated that this application was assigned, an acceptable statement under 37 CFR 3.73(b) is required. Since no such statement accompanied the renewed submission under 37 CFR 1.497(d), it would not be appropriate to grant the requested relief on the basis of the present record.

In response, counsel states (in part) that "we can now definitively conclude that there has never been an assignment recorded in the instant application," and that "obtaining the assent of an assignee is not applicable to the instant application." Counsel is reminded that the requirements for relief under 37 CFR 1.497(d) involve a determination as to whether an assignment has been executed, as opposed to recorded. It is presumed that counsel has performed the due diligence required under 37 CFR 11.18(b)(2) and, as such, the statements with respect to the lack of an assignee are being accepted. If such an interpretation is in error, counsel is required to promptly notify this Office.

The duplicate \$65.00 surcharge under 37 CFR 1.492(h) paid on 12 January 2011 was not required, and is being refunded to counsel.

DECISION

The request under 37 CFR 1.497(d) is **GRANTED**.

This application is being returned to the Office of Patent Application Processing for further processing, including processing of the Power of Attorney signed by the inventor and filed on 13 January 2011. The date of the application under 35 U.S.C. 371(c)(1), (2) and (4) is **12 January 2011**.

/George Dombroske/
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